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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/417,268 | 10/13/1999 | ALEX CHENCHIK | CLON-008 | 7235 |

7590 11/27/2001

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EXAMINER

FORMAN, BETTY J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1655

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------|------------------------|---------------------|
| Advisory Action | Application No. | Applicant(s) |
| | 09/417,268 | CHENCHIK, ALEX |
| | Examiner | Art Unit |
| | BJ Forman | 1655 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 4 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Continuation of Advisory Action.

- 3. Applicant's reply has overcome the following rejection(s): _____.
- 4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
- 6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-17, 53 and 57-77.

Claim(s) withdrawn from consideration: _____.

- 8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

- 9. Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

- 10. Other: _____

Art Unit: 1655

Continuation of Advisory Action

1. This action is in response to papers filed 13 November 2001 in Paper No. 22 in which claims 1 57, 58 and 60 were amended. The amendments have been reviewed but will not be entered because they raise new issues which would require further search and consideration i.e. the new limitation wherein "each [sequence] is attached to the surface of the solid support" would require further search and consideration. Additionally, the amendments will not be entered because they do not place the claims in better form for appeal and because the amendments are not likely to overcome the prior art because the claims as amended read on bacterial colony blots.

The previous rejections in the Office Action of Paper No. 19 dated 5 April 2001 are maintained.

Currently claims 1-17, 53 and 57-77 are under prosecution.

Response to Arguments

2. Applicant argues that the claims as amended are not anticipated by or obvious in view of Letsinger et al. The arguments have been considered but are deemed moot in view of the fact that the amendments have not been entered.

Application further argues that the claims as amended are not obvious in view of Letsinger et al. and Pinkel et al. or in view of Letsinger et al. and Stragene. The arguments have been considered but are deemed moot in view of the fact that the amendments have not been entered.

Art Unit: 1655

Conclusion

3. No claim is allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

W

BJ Forman, Ph.D.
November 20, 2001


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600